

REMARKS

This responds to the Final Office Action mailed on November 29, 2006.

Claims 1, 18, 35, 36 are amended, no claims have been canceled or added; as a result, claims 1-2, 5-19, and 22-36 are pending in this application.

Claim Amendments

The amendments to the claims are fully supported by the specification as originally filed, and no new matter will be added by entry of the amendment. The amendments to the claims are made to satisfy Applicant's preferences, not necessarily to satisfy any legal requirement(s) of the patent laws. The amendments clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

Claim 1 and 35 have been amended to recite, in part: "geolocation activities... to map the network address to a geographic location *associated with the network address*." Claims 18 and 36 have been amended to recite, in part: "geolocation activities to map the network address to a geographic location *of the network address*." (emphasis added for the amended matter).

Support for these additions may be found, for example, in allowable claims 16, 17, 33, and 34 of the present application, which recite, in part: "geolocation information... associated with the network address."

§102 Rejection of the Claims

Claims 1-2, 6-7, 9-15, 18-19, 23-24 and 26-32, 35 and 36 were rejected under 35 U.S.C. § 102(e) for anticipation by Kari et al. (U.S. 6,154,745). This rejection is respectfully traversed.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claims, arranged as in the claim. 35 U.S.C.A. § 102(b), Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, C.A.Fed., 1984.

Claim 1 and 35 have been amended to recite: “geolocation activities... to map the network address to a geographic location *associated with the network address.*” Claims 18 and 36 have been amended to recite: “geolocation activities to map the network address to a geographic location *of the network address.*” (emphasis added for the amended matter).

The Action at page 3 equates the claimed network address with the network address of the user in Kari, and equates the geographic location to a second geolocation (and not to the geolocation of the network address). Kari discloses at col. 8, lines 56-60: “On the basis of the comparison the connection server 3 attempts to find a record which corresponds best to the information asked for, i.e. information on the service. The query can be based either on the location of the user or other data...” Kari discloses at col. 13, lines 5-10: “At this stage the query message is ready to be processed in the remote server. Also in this processing, *the most important search criterion used is preferably the user location,* if it is given in the query message. Thus the remote server *finds out the location of the searched-for service that is closest to the user.*” (emphasis added). Because the user location is used in the query of Kari, it is not the user’s location that is sought, but rather a second location (closest service location to the user).

Because Kari discloses using the user’s location to find a second location (of the closest service location), Kari clearly does not disclose mapping a network address to a geographic location *of the network address*, nor does Kari disclose mapping a network address to a geographic location *associated with the network address*, as claimed in the independent claims, respectively.

Again, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claims, arranged as in the claim.

Because Kari does not disclose: “geolocation activities... to map the network address to a geographic location *associated with the network address*” as claimed in claims 1 and 35, and does not disclose: “geolocation activities to map the network address to a geographic location *of the network address*” as claimed in claims 18 and 36, Kari simply does not disclose each and every element of independent claims 1, 18, 35, and 36, arranged as in each claim, respectively.

Applicant respectfully submits that Kari, therefore, does not anticipate these claims. Accordingly, independent claims 1, 18, 35 and 36 are patentable over Kari, and Applicant respectfully requests that the rejection be withdrawn.

Claims 2, 6-7, 9-15, 19, 23-24 and 26-32 depend from independent claim 1 or 18, and incorporate all of the limitations therein, respectively. Claims 2, 6-7, 9-15, 19, 23-24 and 26-32 are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests notification of same. Applicant considers additional elements of claims 2, 6-7, 9-15, 19, 23-24 and 26-32 to further distinguish over Kari, as applied in the Action, and Applicant reserves the right to present arguments to this effect at a later date.

§103 Rejection of the Claims

Claims 8 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kari in view of Zoken et al. (U.S. 5,944,787).

Claims 5 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kari in view of Reed et al. (U.S. 5,862,325).

These rejections are respectfully traversed.

Claims 5, 8, 22, and 25 depend from independent claim 1 or 18, and incorporate all of the limitations therein, respectively. Claims 5, 8, 22, and 25 are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests notification of same. Applicant considers additional elements of claims 5, 8, 22, and 25 to further distinguish over Zoken and/or Reed, as applied in the Action, and Applicant reserves the right to present arguments to this effect at a later date.

Allowable Subject Matter

Claims 16, 17, 33 and 34 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16, 17, 33 and 34 depend, indirectly, from claims 1 and 18. Because claims 1 and 18 are in condition for allowance, as discussed above; claims 16, 17, 33 and 34 are also

allowable as originally submitted since they are dependent upon claims which are believed to be allowable. Applicant respectfully submits that claims 16, 17, 33 and 34 are in condition for allowance.

Applicant believes the proposed amended claims are patentable, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02, because, among other reasons, the amended claims incorporate claimed matter from allowable and previously presented dependent claims 16, 17, 33 and 34. Accordingly, Applicant submits that claims 1-2, 5-19, and 22-36 are patentable.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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Serial Number: 10/686,102

Dkt: 2054.001US3

Filing Date: October 14, 2003

Title: **METHOD AND SYSTEM TO INITIATE GEOLOCATION ACTIVITIES ON DEMAND AND RESPONSIVE TO RECEIPT OF A QUERY**

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MARK ANDERSON ET AL.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of January 2007.

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